

**AMENDMENTS TO THE DRAWINGS**

Please replace the original drawing sheet 4/13 (FIG. 5) with the enclosed replacement sheet labeled "Replacement Sheet." Changes to FIG. 5 do not add any new matter. The replacement sheet simply adds the text "OR A TWO DIMENSIONAL DATASET OF THE OBJECT" in each of the blocks 82, 84 and 86. These blocks are discussed in paragraphs 10, 12, 31, 35, 43, 49, 53, 55, 58, 59, 65 and 66 of the present application.

**REMARKS**

In the Office Action, claims 12, 14 and 15 were rejected for non-statutory provisional obvious-type double patenting as being unpatentable over claims 9 of Kapur et al., (co-pending U.S. Patent Application No. 10/062,334, hereinafter "Kapur"). Claims 1, 4-6, 8, 11-15, 21, 24 and 25 were rejected under 35 U.S.C. §102(e) as being anticipated by Kapur. Claims 2-3, 9-10 and 22-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kapur in view of Burke et al. (U.S. Patent 6,421,454, hereinafter "Burke"). Claims 7, 16 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kapur in view of Fu et al. (U.S. Patent Application Number 2005/0047544, hereinafter "Fu"). Claims 3, 4, 10, 11, 21, 23 and 25 are objected to because of certain informalities. Claims 17-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

By this paper, Applicants have amended claims 3, 4, 10, 11, 21, 23 and 25 to correct certain informalities and thereby to expedite allowance of the present application. These amendments do not add any new matter. Upon entry of these amendments, claims 1-26 will remain pending in the present application and are believed to be in condition for allowance. In view of the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

**Amendments to drawings**

The Examiner objected to the drawings under 37 C.F.R. 1.83(a) for not showing the recitation of claim 6, which states "2-dimensional (2D) data from which the first image is generated with 3-dimensional (3D) data obtained by scanning the object with the second imaging system". By the present response, FIG. 5 has been amended to show this feature of claim 6 in blocks 82, 84 and 86. A new amended replacement drawing sheet is being provided for this purpose.

The replacement sheet containing FIG. 5 adds the text "OR A TWO DIMENSIONAL DATASET OF THE OBJECT" in each of the blocks 82, 84 and 86. These elements are discussed in paragraphs 10, 12, 31, 35, 43, 49, 53, 55, 58, 59, 65 and 66 of the present application. In view of these amendments, the Examiner's objections to with regard to claim 6 are believed to be overcome.

### **Objection to the Claims**

In the Office Action, the Examiner objected to claims 3, 4, 10, 11, 21, 23 and 25 because of certain informalities.

The Examiner stated that in line 3 of claims 3, 10 and 23, the term "computer-aided design" should be changed to "computer-aided diagnosis" as defined by paragraph 53, line 4 of the specification. The Examiner further stated that in claims 4, 11, 21 and 25, the word "co-ordinates" should be changed to "coordinates". Applicants have amended claims 3, 4, 10, 11, 21, 23 and 25 to adopt these suggestions. In view of these amendments, Applicants respectfully request withdrawal of the objections.

### **Rejections Under 35 U.S.C. §102**

Claims 1, 4-6, 8, 11-15, 21, 24 and 25 were rejected under 35 U.S.C. §102(e) as being anticipated by Kapur. Claims 1, 4-6, 8, 11-15, 21, 24 and 25 are believed to be patentable as discussed below.

In response to the rejection, Applicants affirm that Ajay Kapur, Oliver Richard Astley, and Boris Yamrom, the inventors named in the Kapur reference contributed any common subject matter to the present invention. An affidavit of Mr. Astley is submitted herewith under 37 C.F.R. §1.132 declaring that any invention disclosed but not claimed in Kapur reference was derived from the co-inventors of the present patent application and is therefore not the invention "by another". Thus it is respectfully requested that the rejections of claims 1, 4-6, 8, 11-15, 21, 24 and 25 under 35 U.S.C. §102(e) be withdrawn.

**Rejections Under 35 U.S.C. § 103**

The Office Action summarizes claims 2-3, 9-10 and 22-23 as rejected under 35 U.S.C. § 103(a) as being unpatentable over Kapur in view of Burke. Claims 7, 16 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kapur in view of Fu. Claims 2-3, 7, 9-10, 16, 22-23 and 26 are believed to be patentable as discussed below.

Applicants respectfully point out that the Kapur reference cited by the Examiner is the common primary reference for rejection of all the claims under 35 U.S.C. § 103(a). Applicants also affirm that as has been discussed in relation to the 35 U.S.C. §102(e) rejections above, Ajay Kapur, Oliver Richard Astley, and Boris Yamrom, the inventors named in the common primary reference of Kapur contributed any common subject matter to the present invention. Accordingly, Kumar cannot support a *prima facie* case of obviousness. Applicants request that the rejections on these grounds be withdrawn.

**Claim Rejections under Doctrine of Obviousness-Type Double Patenting**

In the Office Action, the Examiner rejected claims 12, 14 and 15 for nonstatutory provisional obvious-type double patenting as being unpatentable over claim 9 of Kapur. Because, having overcome the rejections as summarized above, this is the only remaining rejection, and, as such it cannot be maintained. As summarized in MPEP 804.I.B:

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.


Applicants therefore request that the Examiner withdraw the non-statutory provisional obvious-type double patenting rejection of claims 12, 14 and 15 of the instant application and permit the application to issue as a patent.

**Conclusion**

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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